

REMARKS

The “Conclusion” section on page 10 of the Office Action dated March 31, 2004 characterizes that action as final, in violation of accepted Patent Office standards, MPEP 706.07(a) (“Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in **37 CFR 1.97(c)** with the fee set forth in **37 CFR 1.17(p)**), and the finality of the current Office Action cannot be sustained.

The “Conclusion” section on page 10 of the Office Action alleges that the applicants’ amendment necessitated the new ground(s) of rejection. Applicants traverse this proposition AS CLEARLY INCORRECT.

Item 5 of the previous Office Action, i.e., of September 26, 2003, rejected originally-filed claim 5 under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 5,978,855 to Metz et al. (“Metz”) in view of U.S. Patent No. 5,235,619 to Beyers, II et al. (“Beyers”). This is the only ground of rejection applied by the Office Action to originally-filed claim 5.

In reply on 12/26/03, the applicants redrafted originally-filed claim 5 into independent form as the new claim 1, and canceled originally-filed claim 5.

The current Office Action, in item 2, rejects claim 1 under 35 U.S.C. 102(e) as anticipated by Metz.

The current Office Action therefore asserts a new ground of rejection for originally-filed claim 5, i.e., current claim 1.

This new ground of rejection for originally-file claim 5, i.e., current claim 1, was not necessitated by the applicant's amendment, which merely changed the format of claim 5 by redrafting it into independent form as the new claim 1. Instead, this new ground of rejection was made in direct response to the persuasiveness of the applicant's 12/26/03 reply (See middle of page 10 to middle of page 12).

IN ADDITION, ALTHOUGH ORIGINALLY-FILED CLAIM 5 (NOW CLAIM 1) WAS NOT REJECTED UNDER 35 U.S.C. 112 IN THE PREVIOUS OFFICE ACTION, THE CURRENT (FINAL) OFFICE ACTION INTRODUCES REJECTION OF ORIGINALLY-FILED CLAIM 5 (I.E., THE CURRENT CLAIM 1) UNDER 35 U.S.C. 112 DESPITE THE FACT THAT THE ONLY CHANGE TO ORIGINALLY-FILED CLAIM 5 WAS TO REDRAFT THE CLAIM INTO INDEPENDENT FORM AS THE CURRENT CLAIM 1. ACCORDINGLY, THE FINALITY OF THE CURRENT OFFICE ACTION IS INVALID AND CANNOT BE SUSTAINED.

For at least the foregoing reasons, the finality of the current Office Action is invalid.

Reconsideration and withdrawal of the finality of the current rejection is respectfully requested, to avoid the need for the applicants to take further measures within the Patent Office.

The Office Action dated March 31, 2004 has been reviewed and carefully considered. Claim 23 has now been added. Claims 1-3, 6-10, 12-16 and 18-23 are now pending, of which the independent claims are 1 and 22. Claims 1 and 22 have been

amended. Reconsideration of the above-identified application, as amended and in view of the following remarks, is respectfully requested.

Claims 1-3, 6-10, 12-16 and 18-22 stand rejected under 35 U.S.C. 112, second paragraph.

As to claim 1, page 2 of the Office Action suggests, to the best of the applicants' understanding, that it is unclear whether claim 1 is directed to an apparatus or a method. Claim 1 has now been amended, but not for any reason related to the current rejection. Support for the amendment of claim 1 is found in the specification (e.g., page 5, lines 11-14; page 7, line 22 – page 8, line 2).

This current rejection, although purportedly asserting that the claim language is confusing, appears to be somewhat shy of Section 101 rejection.

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title. 35 U.S.C. 101

An example of a “machine” in accordance with 35 U.S.C. 101 is found in FIG. 1 of the present invention (ref. nos. 10, 12, 14, 15 and 17) (See also, specification, page 5, line 20: “CATV”).

Claim 1, before and after its current amendment, recites, “A . . . system comprising a transmitter and at least one receiver. . .” which is a machine in accordance with 35 U.S.C. 101.

Page 2 of the Office Action suggests that certain claim limitations of the machine are “drawn to a method.” The applicants fail to understand this suggestion, at

least since the claim limitations questioned by the Office Action further define the structure of the machine being claimed.

As to the suggestion by the Office Action that the claims are confusing, the applicants submit that one of ordinary skill in the art would not find the claims confusing.

Claim 22 is similar to claim 1, and the Office Action questions the same structures in the same way, and likewise fail to state any proper basis for rejecting the claims.

Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 1-3 stand rejected under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 5,978,855 to Metz et al. ("Metz").

Claim 1 as amended recites:

predetermined groups of file and directory objects being formed into respective modules at the transmitter, with each module being transmitted as a whole, and the receiver being arranged to store, for retrieval upon subsequent playback, received file data and directory objects under a predetermined grouping formulation, wherein the file and directory modules are comprised in discrete data portions carried in an elementary data stream, with said predetermined grouping formulation for storage being at the module level

Advantages of the inventive storage technique discussed in the specification, and are contrasted with the conventional (specification, page 7, line 5: "regular") process which causes file administration to "becomes extremely complex" (page 7, line 8).

The Metz reference, although directed to software-downloading by means of a carousel, fails to disclose or suggest the above, latter-quoted limitation of claim 1 of the present invention.

Item 2 of the Office Action offers lines 10-24 of column 47 of Metz. This passage, however, describes the typical higher incidence of repetition in the carousel for items requiring quick access, and is silent as to any data structure for stored file data and directory objects.

Item 2 next offers lines 3-22 of column 35 of Metz. This passage, however, “a receiver being arranged to store . . . at the module level” as explicitly required by the language of claim 1.

Apparently recognizing this latter shortcoming, the previous Office Action, of 9/26/03, states on page 5 “Metz ‘855 fails to disclose wherein the file and directory modules are comprised in discrete data portions in an elementary stream, with said predetermined group formulation for storage being at the module level.” The 9/26/03 Office Action then attempts to make an obviousness rejection based on Metz/Beyers, citing Beyers for disclosure of a module. The applicants’ reply seems to be persuasive in setting forth the invalidity of the Metz/Beyers rejection, since the current Office Action abandons the Metz/Beyers rejection.

Item 2 of the current Office Action, however, asserts a Metz anticipation rejection and deals with the above-quoted language by ignoring it, presumably therefore suggesting that the language lacks patentable weight. This suggestion is likewise incorrect.

"All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

MPEP 2143.03.

Perhaps sensing inadequacy in the above-stated ground for rejection, the “Response to Arguments” section asserts points of argument for the rejection.

Firstly, the Office Action reiterates the previously-noted Section 112 rejection which, as noted above, is invalid.

Secondly, the Office Action cites as prior art lines 10-18 of page 2 of the present specification, and suggests that this passage discloses “said predetermined grouping formulation for storage being at the module level.”

For clarity, claim 1 has been amended to recite:

respective modules at the transmitter, with each module being transmitted as a whole, and the receiver being arranged to store, for retrieval upon subsequent playback, received file data and directory objects under a predetermined grouping formulation, wherein the file and directory modules are comprised in discrete data portions carried in an elementary data stream, with said predetermined grouping formulation for storage being at the module level

The passage in the specification cited by the Office Action relates to retrieval of a module from the incoming transport stream, not to any data structure in storage (specification, page 2, lines 23-25: “. . . the DSM-CC object carousel for the purpose of pre-fetching objects requires a lot of processing in the set-top box.”) This point of argument is therefore likewise invalid.

The other independent claim, claim 22, has now been amended to include the language revision in the current amendment of claim 1 and to otherwise be identical with originally-filed claim 4.

While claim 1 is directed to “said predetermined grouping formulation for storage being at the module level,” claim 22 is directed to “said predetermined grouping

formulation for storage being at the elementary level.” The Metz reference likewise fails to disclose or suggest a formulation at the elementary level, at least because Metz fails to disclose or suggest such a data structure of any stored carousel data at the receiver. None of the other references can make up for the deficiencies in Metz.

Claims 4, 10 and 16 stand rejected under 35 U.S.C. 103(a) as unpatentable over Metz in view of U.S. Patent Publication No. 2001/0022001 to Hiroi.

Claim 4 was canceled in the prior reply.

Claims 10 and 16 both depend from claim 22.

As to claim 22, it recites:

A transmission system comprising a transmitter and at least one receiver configured to receive signals transmitted therefrom, wherein carousel-forming data file and directory objects are sent in cycles with predetermined groups of file and directory objects being formed into respective modules at the transmitter, with each module being transmitted as a whole, and the receiver being arranged to store, for retrieval upon subsequent playback, received file data and directory objects under a predetermined grouping formulation, wherein the file and directory modules are comprised in discrete data portions carried in an elementary data stream, with said predetermined grouping formulation for storage being at the elementary level

FIG. 3 of Hiroi shows storage of an information stream. If the Metz object carousel program download embodiment were to be modified to feature Hiroi demultiplexing of an information stream into storage 365, this would suggest no more than a conventional top layer (specification, page 7, line 4: “top layer”) storage scheme. The Metz/Hiroi conventional top layer storage scheme could not properly be characterized as storage of “carousel-forming data file and directory objects” “under a predetermined grouping formulation, wherein the file and directory modules are

comprised in discrete data portions carried in an elementary data stream, with said predetermined grouping formulation for storage being at the elementary level.”

For at least this reason, the applied references fail to render obvious the invention as recited in claim 22, and dependent claims 10 and 16.

Claims 5, 11 and 17 stand rejected under 35 U.S.C. 103(a) as unpatentable over Metz in view of U.S. Patent No. 5,235,619 to Beyers, II et al. (“Beyers”).

Claim 5 was redrafted into independent form as the new claim 1 in the prior Office Action reply. Former claim 5 is therefore claim 1.

Claim 1 recites:

wherein carousel-forming data file and directory objects are sent in cycles with predetermined groups of file and directory objects being formed into respective modules at the transmitter, with each module being transmitted as a whole, and the receiver being arranged to store, for retrieval upon subsequent playback, received file data and directory objects under a predetermined grouping formulation, wherein the file and directory modules are comprised in discrete data portions carried in an elementary data stream, with said predetermined grouping formulation for storage being at the module level

As item 5 of the prior Office Action acknowledges, Metz fails to disclose or suggest the claim 1 limitations particular to former claim 5, i.e.,

wherein the file and directory modules are comprised in discrete data portions carried in an elementary data stream, with said predetermined grouping formulation for storage being at the module level

Item 5 of the current (and prior) Office Action cites lines 49-61 of column 51 of Beyers as disclosing the above-quoted language particular to former claim 5.

However, the cited passage in Beyers relates to calibration by an external controller of transmit levels of a module that incorporates a data transmitter for returning

data sent to a set-top box. Presumably, item 5 of the Office Action is suggesting that Metz discloses a "module" in the sense that such a term is understood in the context of the claim limitations particular to former claim 1. A fair reading of current claim 1, however, makes it unclear how the meaning being suggested for the word "module" in the first part of the claim, based on Metz, could be assigned a meaning different from meaning being suggested for "module" in the second part of the claim, based on Beyers. That is, it is unclear how the Beyers module relates to the module of current claim 1 which, by the explicit language of current claim 1, is created by "predetermined groups of file and directory objects being formed into respective modules at the transmitter, with each module being transmitted as a whole." For at least this reason, it is unclear how it can properly be said that the purported Metz/Beyers features an embodiment with "said predetermined grouping formulation for storage being at the module level" as explicitly required by the language of claim 1. It appears as though item 5 of the Office Action is suggesting that the latter-quoted limitation of claim 1 be simply ignored for purposes of examination in the Patent Office, but such a notion would be contrary to proper claim interpretation.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under **35 U.S.C. 103**, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.03.

Metz/Beyers fails to disclose or suggest “said predetermined grouping formulation for storage being at the module level” as explicitly specified in the language of claim 1 and fails to render obvious the invention as recited in claim 1 for at least this reason. Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 6, 12 and 18 stand rejected under 35 U.S.C. 103(a) as unpatentable over Metz in view of U.S. Patent Publication No. 2002/0091816 to Stalker.

Claims 6, 12 and 18 each depend from claim 1. Stalker cannot make up for the deficiencies in Metz. For at least this reason, Metz/Stalker fails to render obvious the invention as recited in claims 6, 12 and 18.

Claims 7-9, 13-15 and 19-21 stand rejected under 35 U.S.C. 103(a) as unpatentable over Metz in view of U.S. Patent Publication 2002/0188950 to Soloff et al. (“Soloff”).

Claims 7-9, 13-15 and 19-21 each depend from claim 1. Soloff cannot make up for the deficiencies in Metz. For at least this reason, Metz/Soloff fails to render obvious the invention as recited in claims 7-9, 13-15 and 19-21.


New claim 23 has been added to emphasize aspects of what it is the applicants regard to be the invention, and finds support in the specification (e.g., page 3, lines 13-16). Claim 23 depends from claim 22, and is patentable for at least the same reasons as set forth above with regard to claim 22.

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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